



Attorney Docket No.47777-0005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Christian MAYAUD

RECEIVED

Serial No. : 09/941,681

JUN 10 2004

Filing Date : August 30, 2001

Technology Center 2100

Title : A COMPUTERIZED PRESCRIPTION SYSTEM FOR
GATHERING AND PRESENTING INFORMATION
RELATING TO PHARMACEUTICALS

Examiner : Samuel G. Rimell

Group/Art Unit : 2175

Commissioner for Patents
Alexandria, VA 22313-1450

DECLARATION OF PRIOR INVENTION IN THE UNITED STATES

**•OR IN A NAFTA OR WTO MEMBER COUNTRY
TO OVERCOME A CITED PATENT OR PUBLICATION**

37 C.F.R. § 1.131

1. I, Christian Mayaud, am the named inventor of the '681 Application.
2. The present '681 Application is a continuation of United States Patent Application serial number 09/121,597, filed July 24, 1998, which is a continuation of United States Patent Application serial number 08/942,372, filed October 2, 1997 (now U.S. Patent number 5,845,255); which is a continuation of U.S. Patent Application serial number 08/330,745 (the '745 Application) filed October 28, 1994 (now abandoned).
3. On a date prior to December 13, 1993, I made a confidential presentation to a third party regarding my invention then called "Physicians' Online." In support for that presentation, I

provided a handout, a copy of which is attached hereto as Exhibit A, (all dates on submitted materials have been redacted), this handout material is numbered POL 03771 through POL 03783. This handout, Exhibit A, bears a printed date thereon (redacted) at page marked POL 03771, which shows the date that the meeting took place, a date prior to December 13, 1993. In further support of the date of this said meeting, attached hereto as Exhibit B, document no. POL 05667, is a copy of two pages from my personal calendar. In my writing there is displayed on the left side a morning entry, showing my "9:30" meeting (third party name and meeting location redacted) which date, printed on my calendar (redacted), is prior to December 13, 1993. This corroborates the date on the handout and the date the meeting took place prior to December 13, 1993. Other writings on this Exhibit B sheet reflect my notes of the parties in attendance at the meeting.

4. On another date prior to December 13, 1993, I made another confidential presentation to another third party regarding said invention "Physicians' Online." In support for that presentation, I provided a handout, a copy of which is attached hereto as Exhibit C. This handout material is numbered THB12195 through THB12206. This handout, Exhibit C, bears a printed date thereon (redacted) at page marked THB 12195, which shows the date that the meeting took place, a date prior to December 13, 1993. This corroborates the date the meeting took place prior to December 13, 1993.

5. On another date prior to December 13, 1993, I made another confidential presentation to another third party regarding my said invention "Physicians' Online." In support for that presentation, I provided a handout, a copy of which is attached hereto as Exhibit D. This handout material is numbered THB 08060 through THB 08072. This handout, Exhibit D, bears a

printed date thereon (redacted) at page marked THB 08060, which shows the date that the meeting took place, a date prior to December 13, 1993. This corroborates the date the meeting took place prior to December 13, 1993.

6. On another date prior to December 13, 1993, I made a confidential presentation to a third party regarding my said invention "Physicians' Online." In support for that presentation, I provided a handout, entitled Business Summary PHASE 1 Medical Knowledge Management, which is attached hereto as Exhibit E, having document numbers POL 03290 through POL 03348. This handout, Exhibit E, bears a printed date thereon (redacted) at page marked POL 03290, which shows the date that the meeting took place, a date prior to December 13, 1993. This corroborates the date the meeting took place prior to December 13, 1993.

7. On another date prior to December 13, 1993, I made a confidential presentation to a third party regarding my said invention "Physicians' Online." In support for that presentation, I provided a handout, entitled PHASE 1 Business Plan Medical Knowledge Management, which is attached hereto as Exhibit F, having document numbers POL 02223 through POL 02301. This handout, Exhibit F, bears a printed date thereon (redacted) at page marked POL 02223, which shows the date that the meeting took place, a date prior to December 13, 1993. This corroborates the date the meeting took place prior to December 13, 1993.

8. On another date prior to December 13, 1993, I made a confidential presentation to a third party regarding my said invention "Physicians' Online." In support for that presentation, I provided a handout, entitled Physicians' Prescribing Network, which is attached hereto as Exhibit G, having document numbers THB 06006 through 06042. This handout, Exhibit G, bears a printed date thereon (redacted) at page marked THB 06006, which shows the date that

the meeting took place, a date prior to December 13, 1993. This corroborates the date the meeting took place prior to December 13, 1993.

9. On another date prior to December 13, 1993, I sent a facsimile transmission of at least a one page document entitled "Physicians' Online: 5 year Plan," regarding my said invention, which is attached hereto as Exhibit H, having document number THB 07125. This document, Exhibit H, bears a printed date thereon (redacted) at page marked THB 07125, which shows the date of the facsimile transmission, a date prior to December 13, 1993.

10. All of the handouts and presentations referenced above in paragraphs numbered 3 through 9 support that my said invention "Physicians' Online," as presently embodied in at least claim 70 of the '681 Application, was invented by me, and was conceived by me, prior to December 13, 1993.

11. On a date prior to December 13, 1993, I retained a Patent Law Firm to file a patent application for my said inventions. From a date prior to December 13, 1993 and up to October 28, 1994 I continuously and regularly met on numerous occasions with my patent attorney who drafted my patent application. During this time I met with my patent attorney approximately two days per month at his offices so as to review his progress on this sizeable disclosure and his drafts, which I reviewed and edited. As a result of continuous and diligent meetings with my patent attorney, a patent application was drafted resulting in the '745 Application, which had 172 typewritten pages in the specification and having 16 sheets of drawings. The '745 Application was filed with 69 claims which included three independent claims. In order to draft this application, considerable amount of time was necessary to meet with my patent attorney and review each claim as well as to review the entire specification and the drawings and flow charts.

The specification drafted by my patent attorney included at least 35 separate sections detailing and describing my invention, which required the numerous meetings with my patent attorney to draft. On information and belief, my personal calendar would support these visits with my patent attorney. At the present time my said calendar is not in my control. It may come into my control at a date in the future pending third party litigation.

12. At all times from a date prior to December 13, 1993 through the filing date of my '745 Application, both my patent attorney and I were diligent in preparing and filing my '745 Application for patent.

13. The power point slide show presentation produced and filed in my earlier section 131 declaration for this '681 Application was developed by me on a date prior to December 13, 1993. The actual presentation was presented to several companies under confidentiality agreements on dates prior to December 13, 1993.

14. All of the handouts and presentations referenced above in paragraphs numbered 3 through 9 illustrate that I invented the subject matter of claim 70 of the '681 Application prior to December 13, 1993. In particular, I note the following:

- a prescription creation screen having prescriber-operable data capture devices is illustrated on document nos. THB 06017 and 06036; and POL 02237, 02242, 02247, 02271, 02273, 03779, 03780, 03781, 03545, and 03548 of the enclosed materials;
- a patient identifier data capture device for capturing patient-identifying data is illustrated on document nos. THB 06010, 06012, 06015, 06017, and 06036; and POL 02243, 02247, 02271, 03545, and 03548 of the enclosed materials;

- a prescribed drug data capture device for capturing prescribed drug identification data is illustrated on document nos. THB 06010, 06011, and 06012; and POL 02246, 02247, 02248, 02261, 02271, 02273, 03779, 03780, 03781, 03545, and 03548 of the enclosed materials;
- at least one drug quantifier capture device for capturing drug quantification data is illustrated on document nos. THB 06036 and POL 02247, 02248, and 02271 of the enclosed materials;
- a patient condition data capture device to capture patient condition data regarding said patient condition exhibited by said patient whereby said electronic prescription further comprises said patient condition data is illustrated on document nos. THB 06010 and 06017; and POL 02243 and 02271 of the enclosed materials;
- a library of prescribable drug data accessible by one or more of said data capture devices from said prescription management screen to display multiple prescribable drugs is illustrated on document nos. THB 06010, 06011, and 06012; and POL 02236, 02246, 02248, 02261, 02273, 03545, 03548, and 03549 of the enclosed materials;
- a prescription output screen device to output a completed prescription is illustrated on document nos. THB 06012 and 06036; and POL 02246 of the enclosed materials.

15. I actually utilized the subject matter of claim 70 to write and generate an electronic prescription for viewing on a prescription creation screen and printed it out prior to

December 13, 1993. The prescription was printed on a printer and included the patient condition and identification and quantification data regarding a drug prescribed by me for treatment of the patient condition, the patient condition and drug data being captured into the prescription by the data capture devices. To the best of my knowledge a copy of this prescription would still be in memory of my original computer, which at the time of making this declaration, said computer is in storage in a location not in my present control.

DECLARATION

I, Christian Mayaud, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Christian Mayaud

Christian Mayaud
2 Governors Road
Bronxville NY 10708

Date: 6/4/04

EXHIBIT A



Physicians' Online

M

Handout

Christian Mayaud, MD
Chief Executive Officer

Steven Hochberg
Chief Operating Officer

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PHYSICIANS' ONLINE, Inc.

230 Park Avenue • 8C-301 • New York • New York 10169
212/338-9343 | 212/724-2032 | Fax: 212/724-0849

FAX 03772

"The success of managed care will probably depend on the ability of these organizations to influence physicians' choices in the direction of increased value."

-- John K. Iglehart. Managed Care. *N Engl J Med* 1992; 327: 742.

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FOL 03772



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FOL 03773

I - The Executive Summary

Physicians' Online is a personalized online medical information and communications service dedicated to empowering physicians with the tools essential to advance the quality and control the cost of health care through informed decision-making.

Physicians' Online ("Company") is an innovative new electronic medium designed to evolve into a comprehensive national medical information and communications network servicing the entire health care industry. The Company's online information products and communication services provide physicians with powerful tools to manage Medical Knowledge, Prescriptions, and Patients. **Physicians' Online** provides a distribution outlet for third-party produced information products and services. **Physicians' Online** also provides valuable proprietary information services to other industry participants including managed care organizations and the pharmaceutical industry.

Phase I - Medical Knowledge Management

Online medical information and communication services which are readily accessible and free of charge to member physicians through optional online advertising support. The Company has assembled the most powerful, yet user-friendly, collection of medical information tools available from leading third-party sources. The core information products target three key areas of identified information need, including medical literature (MEDLINE), medical diagnosis (QMR), and drug information (USP). **Physicians' Online** is being developed in cooperation with major medical societies, pharmaceutical manufacturers & marketing organizations, hospitals, managed care organizations, and leading technology & third-party content providers.

Implementation: 1993 through 1994

Phase II - Prescription Management

Online prescription fulfillment and cost containment programs made possible through the use of "Smart Electronic Prescription Pads" (PDAs). This network is being developed in cooperation with managed care organizations, hospitals, pharmacists, pharmaceutical distributors, leading technology providers, and other health-care participants.

Implementation: 1994 through 1996

Phase III - Patient Management

Online patient information for efficient retrieval and transaction processing resulting in enhanced clinical and administrative efficiency and cost-containment. This network is being developed in cooperation with corporate employee benefits programs, private health insurance carriers, out-patient laboratories, electronic claims processors, installment credit organizations, hospitals, and other health care participants.

Implementation: 1995 through 1997

The Company's competitive advantage is based on its ability to attract physician use. Founded by practicing physicians with extensive experience delivering practical information products to busy clinicians, the Company has developed a market-driven product strategy designed to win maximum professional acceptance and use. The Company is establishing critical strategic alliances with leading participants in every major health care market segment. The Company is currently working with several leading content and service providers to develop new products and services for this expanding multi-billion dollar market opportunity.

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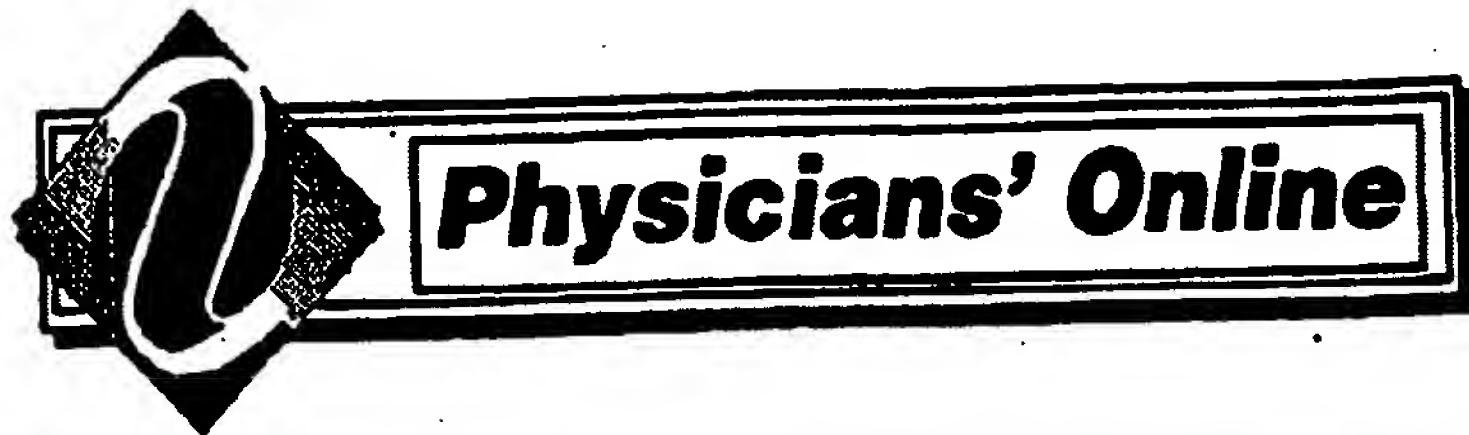
Physicians' Online: 5 Year Plan

To empower physicians with the tools essential to advance the quality and control the cost of health care through informed decision-making.

Time Frame	Phase I		Phase II		Phase III	
	0-2 yr	Medical Knowledge Management	1-4 yr	Prescription Management	3-5 yr	Patient Management
Essential Tools		Physicians' Online		Pharmacists' Online Pharm Reps' Online Formularies Online Managed Care Online		National Health Card Network
Vehicle						
Potential Membership		500,000 physicians 10,000 pharmaceutical execs		300,000 physician offices 100,000 pharmacies 50,000 drug reps		250 million patients 10,000 hospitals other health care participants
Core Markets		MEDLINE Rx Micromarketing		Prescription Fulfillment Rx Cost-Containment		Patient Administration Cost-Containment Programs
Market Size		\$50 million / \$7 billion		>\$70 billion		>\$500 billion
Market Size/MD		\$500 / \$15,000		>\$150,000		>\$1,000,000
Secondary Markets		<ul style="list-style-type: none"> • Clinical Databases • Decision-Support Tools • News & Financial Services • Special Interest Forums • other areas of identified need 		<ul style="list-style-type: none"> • Home Care • Managed Care • Formularies • Pharmacy Network • "Electronic Detailing" & Rep Support 		<ul style="list-style-type: none"> • Electronic Patient Record • Outpatient Laboratory Transactions • Patient Health Maintenance
Main Revenue Sources		<ul style="list-style-type: none"> • Pharmaceutical Advertising • Pharmaceutical Micromarketing Information • Membership & Usage Fees 		<ul style="list-style-type: none"> • Prescription Processing • Micromarketing Information • Membership & Usage Fees 		<ul style="list-style-type: none"> • Patient Transaction Processing • Communication Services • Micromarketing Information • Membership & Usage Fees
Competitive Advantages		<ul style="list-style-type: none"> • "Medical Info Vending Machines" • Sophisticated MD Targeting ("Ad Wizard" / "Smart Ads") • Installed Terminals, PDAs, & PCs • Computer-Sophisticated Members • Medical Society Support • Pharmaceutical Industry Support • Third-Party Office Systems Support • Pharmaceutical Executives' Online • User-Friendly Interface • Proprietary Text-Retrieval Software • Proprietary Psychometric Marketing Data 		<ul style="list-style-type: none"> • "Smart Electronic Prescription Pads" (PDAs) • Installed Terminals, PDAs, & PCs • Automated Prescriber Assistance Programs • Proprietary managed care applications • National Electronic Formularies • Proprietary Prescriber Profiling • Patient Prescription Profiles • Proprietary Psychometric Marketing Data 		<ul style="list-style-type: none"> • "National Health Card" • Installed-base of diverse POS/PON entry-points linking integral industry participants • Electronic Patient Transactions Network • Third-Party Office Systems Support • Hospital Systems Support • Cellular Communications Link to Physicians
Strategic Alliances		<ul style="list-style-type: none"> • Medical & Professional Societies • Pharmaceutical Companies • Pharmaceutical Marketing Cos • Prescription Data Marketing Companies (IMS/ MMG/ PMS) • Third-party Content Providers (NLM/ Cendat/ USP) • Medical Office System Companies • Technology Providers (CompuServe/ Sybase/ Conquest/ Cerner/ Apple/ Sun/ HP/ Cube) 		<ul style="list-style-type: none"> • Prescription Fulfillment Companies (Medco) • Pharmacies/Pharmacist Societies • Managed Care Organizations • HMOs/ PPOs/ IPAs • Hospital Chains • Hospital Formularies • Corp Employee Benefits Programs • Medical Office System Companies • Technology Providers (AT&T/ Apple/ EO/ Motorola/ HP) 		<ul style="list-style-type: none"> • Corp Employee Benefits Programs • Private Health Insurance Carriers • BCBS/ Medicaid/ Medicare • Out-Patient Labs (MetPath/ BioScience/ SKF/ NHL) • Outpatient Testing Companies • Installment Credit Organizations • Electronic Claims Processing & Clearing Houses (NEC/ EDS) • Medical Office & Hospital Systems Companies
Technical Technologies		<ul style="list-style-type: none"> • Systems Integration of existing hardware & software technology • Packet Data Network technology • Simple Text Retrieval Software • Third-party Content Development 		<ul style="list-style-type: none"> • "Personal Digital Assistants" (PDAs) • Data network technology • Proprietary PDA applications development • Personal Info Management (PIM) 		<ul style="list-style-type: none"> • Systems Integration • Proprietary patient administration & cost-containment applications development • Cellular data network technology
Infrastructure Milestones		<ul style="list-style-type: none"> • 150,000 physician members • 5,000 hospital members • 5,000 hospital-based terminals • 5,000 PDAs in Physician Offices • 150,000 additional POS software installations 		<ul style="list-style-type: none"> • 300,000 physician members • 10,000 hospital members • 20,000 hospital-based terminals • 100,000 PDAs in Physician Offices • 10,000 mobile PDAs • 500,000 additional POS software installations 		<ul style="list-style-type: none"> • 500,000 physician members • 10,000 hospital members • 50,000 hospital-based terminals • 300,000 PDAs in Physician Offices • 400,000 mobile PDAs • 500,000 additional POS software installations
Infrastructure		\$10,000,000		\$50,000,000		\$250,000,000
Infrastructure/MD		\$100		\$200		\$500

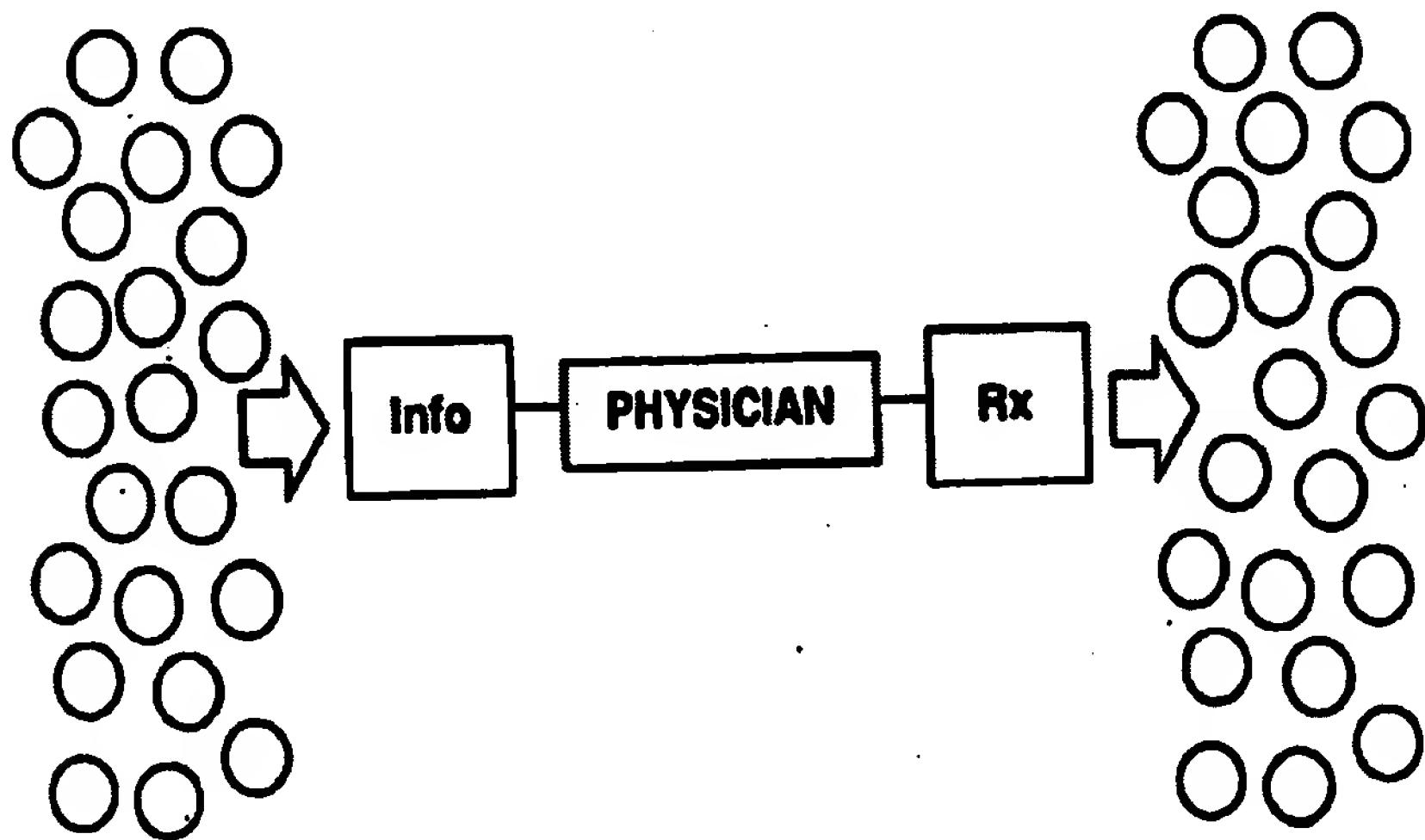
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FBI - LOS ANGELES



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Physician as Knowledge Worker Problem & Opportunity

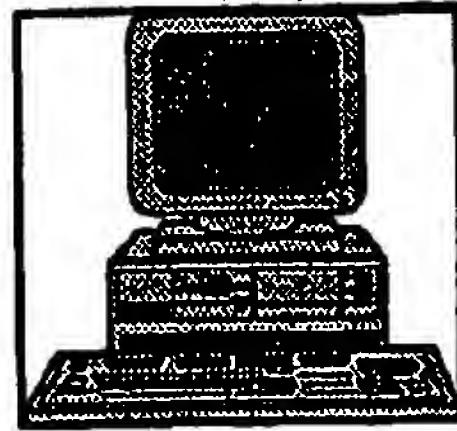


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FILE NUMBER



PCs in Health Care



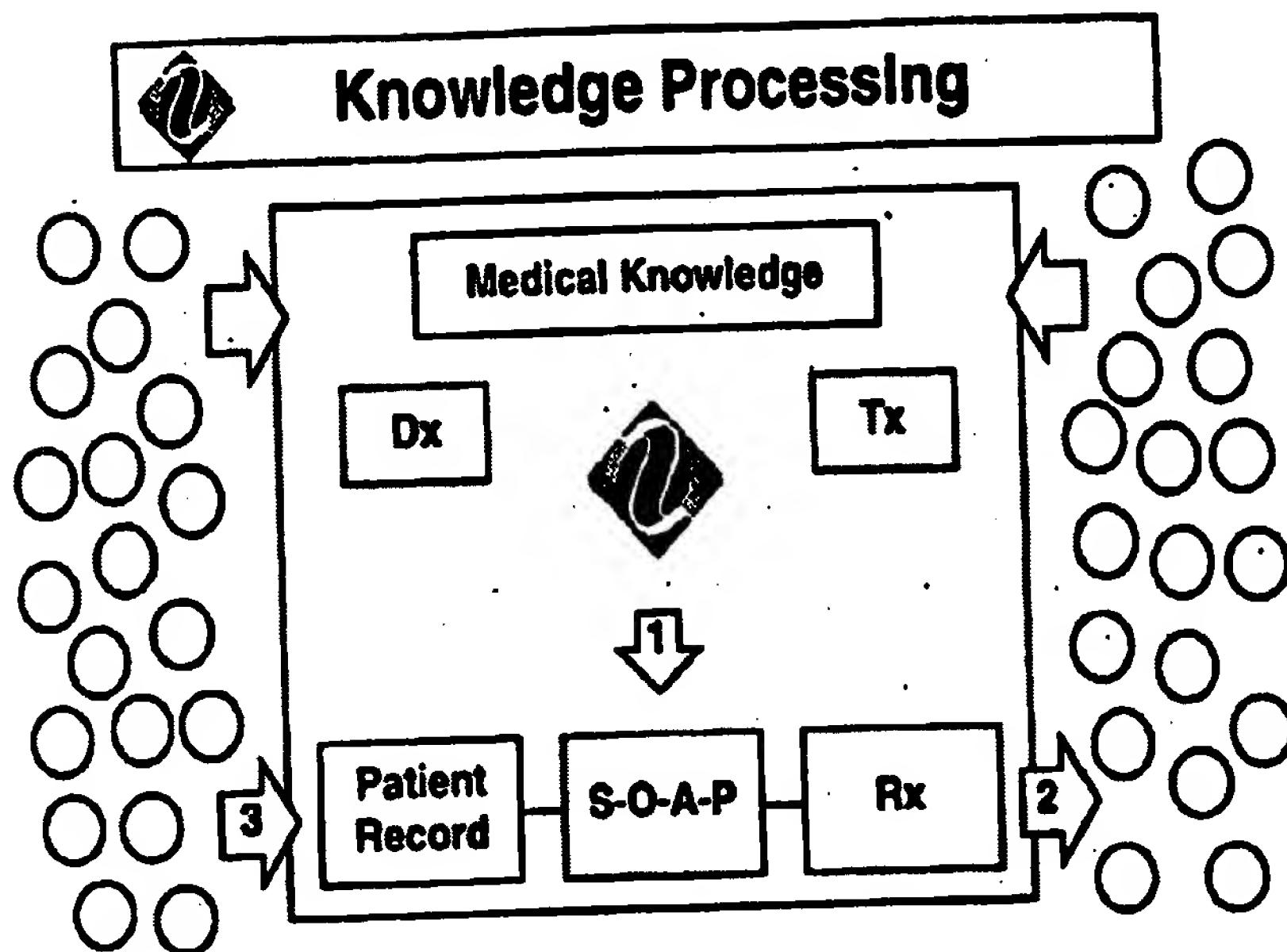
Desk-bound Document Processing

Barriers to Physician Use

- Price
- Access
- Ease of Use
- Awareness
- Time

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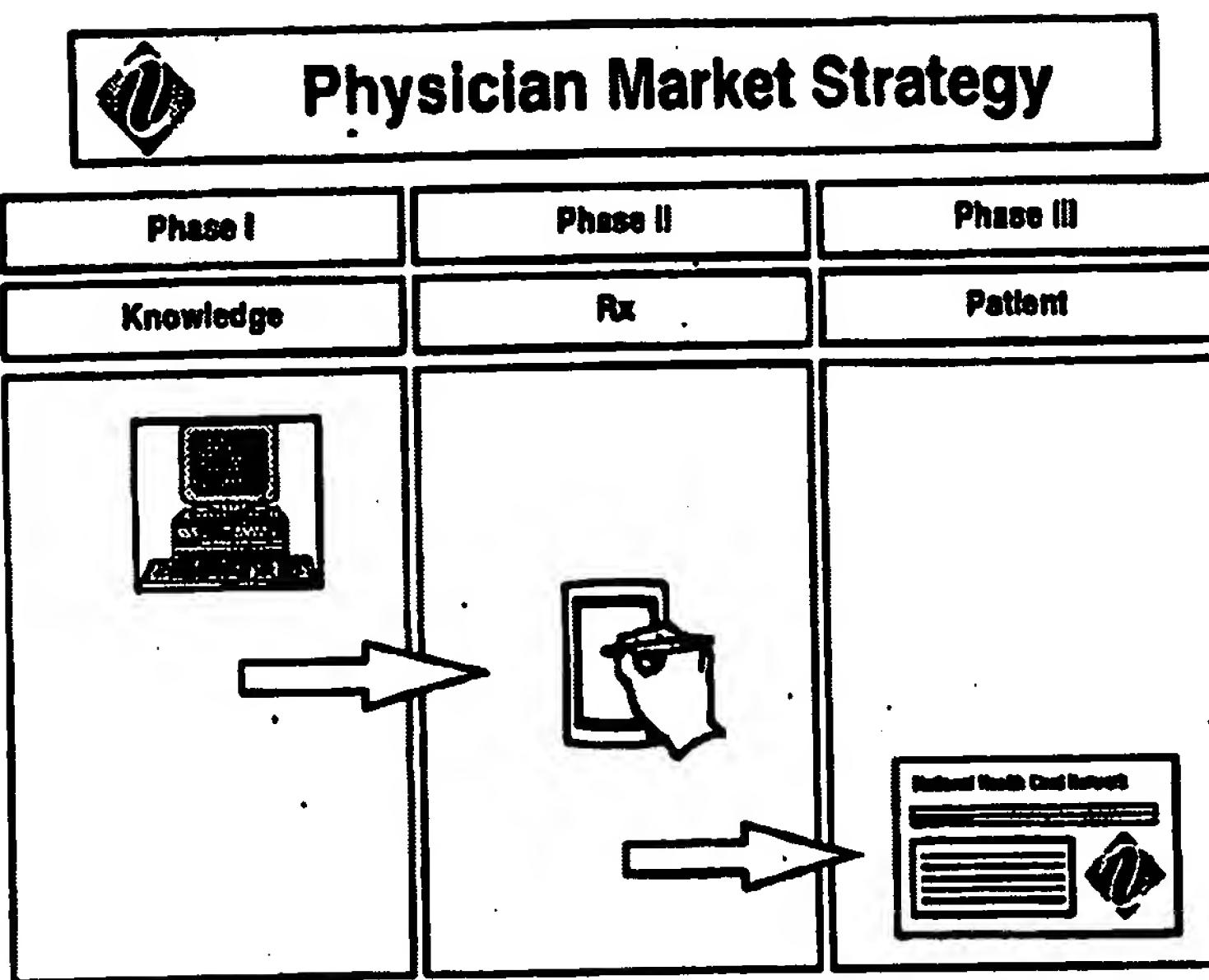


Desk-bound
Document Processing

Mobile
Knowledge Processing

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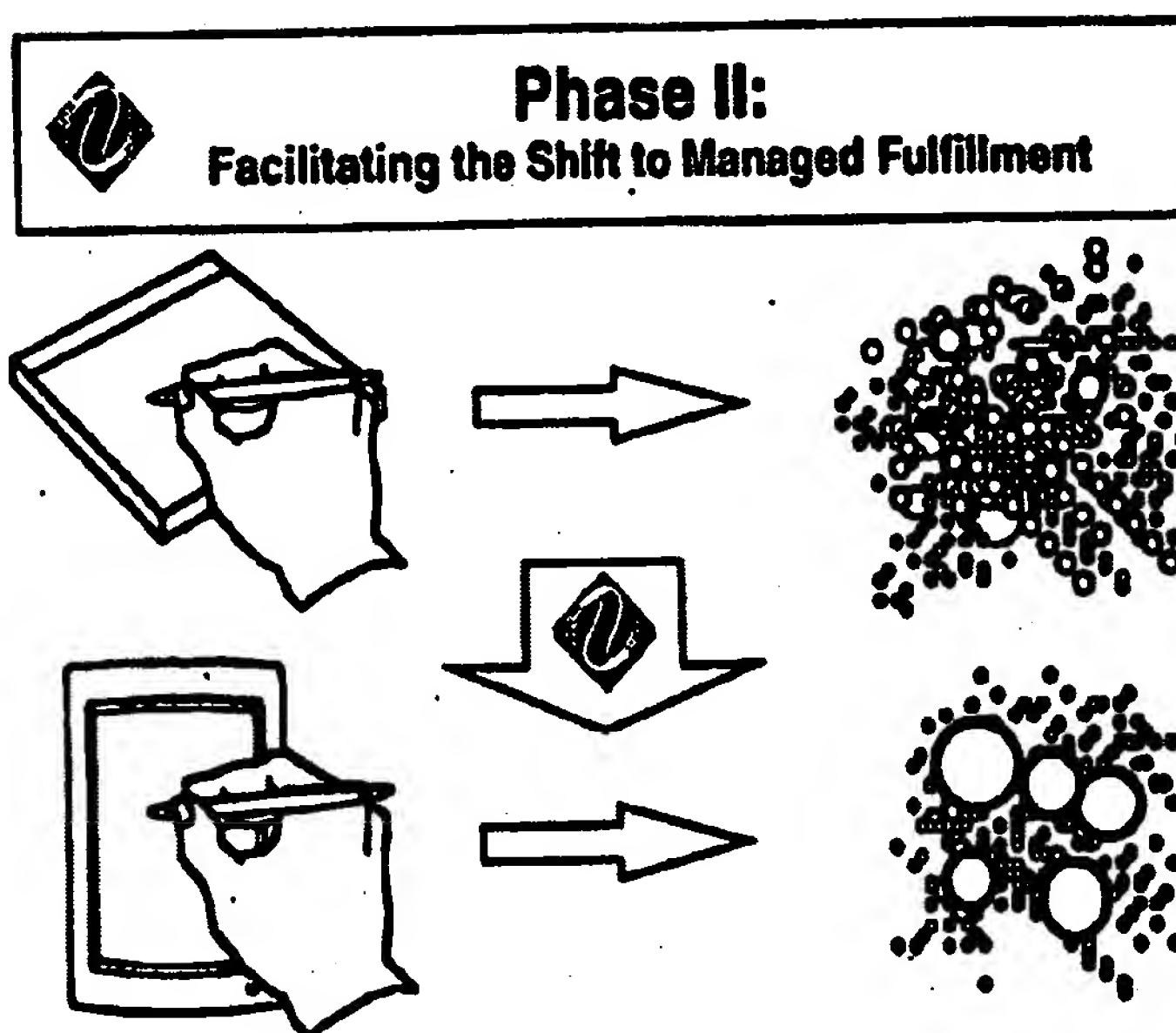
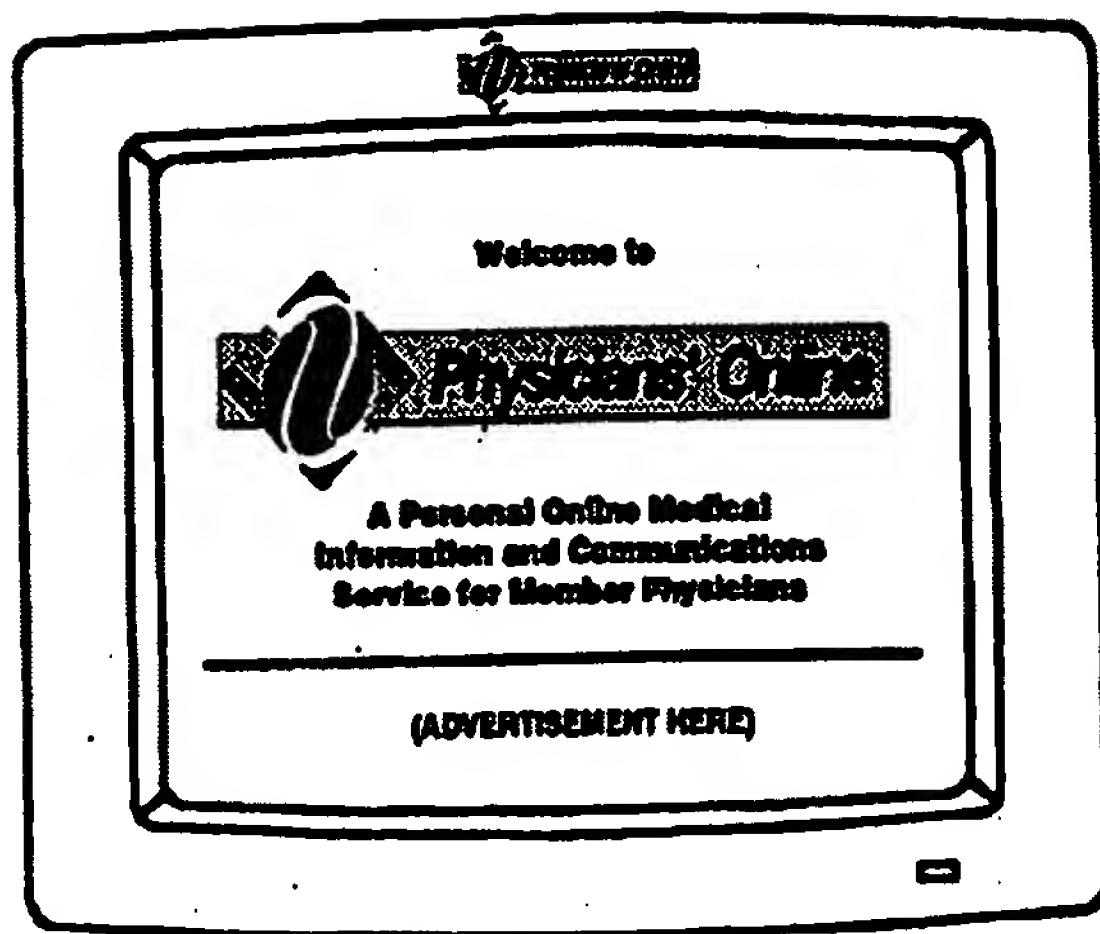
Strategic Alliances

- **Phase by Phase**
Sector by Sector Cooperative Participation
- **Cooperative vs Competitive**
Market Growth vs Market Share
- **Physician "Desktop" Control**
First Mover Advantage
Physician Use: All or Nothing

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Medco/MMG
12-Jan-93

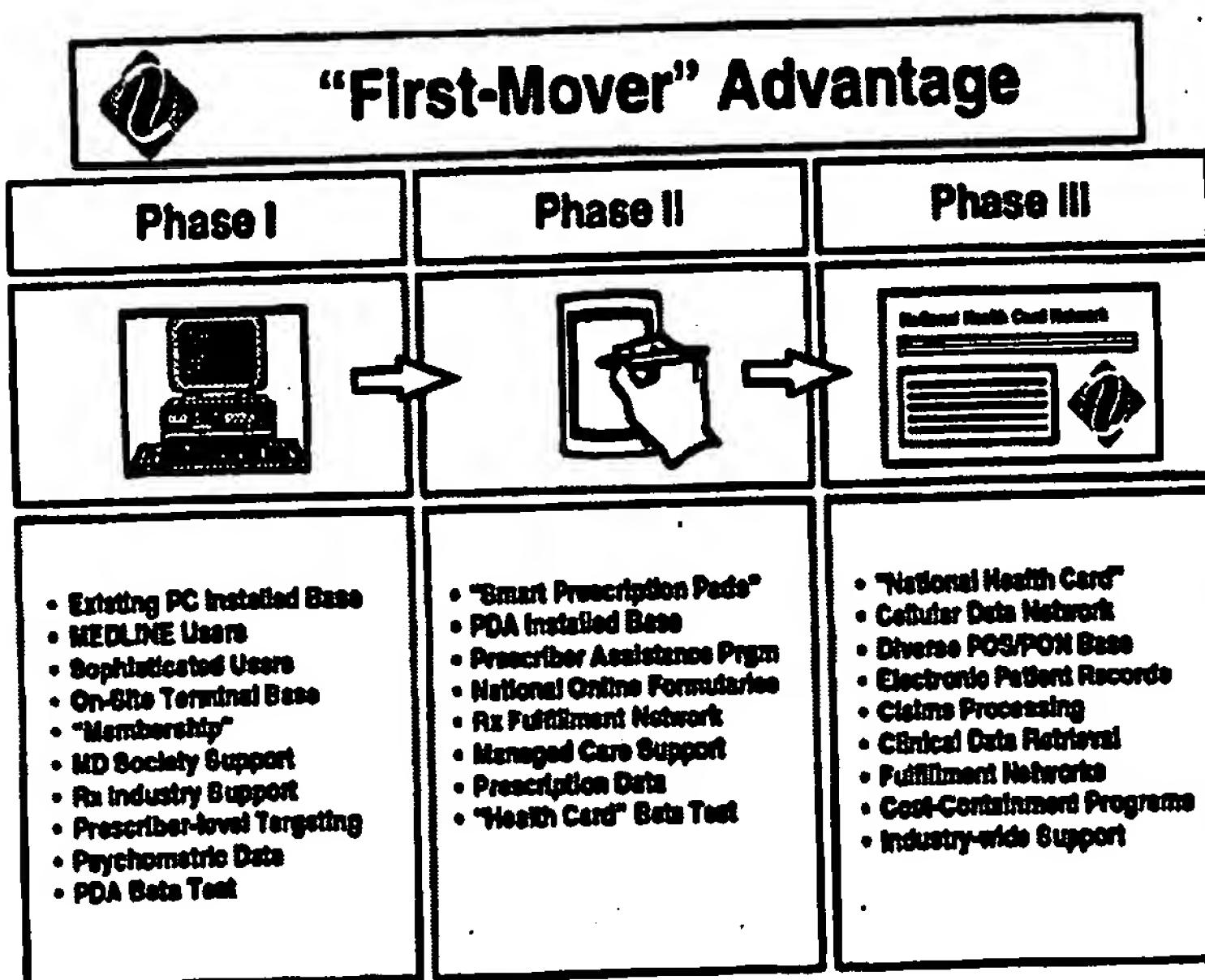


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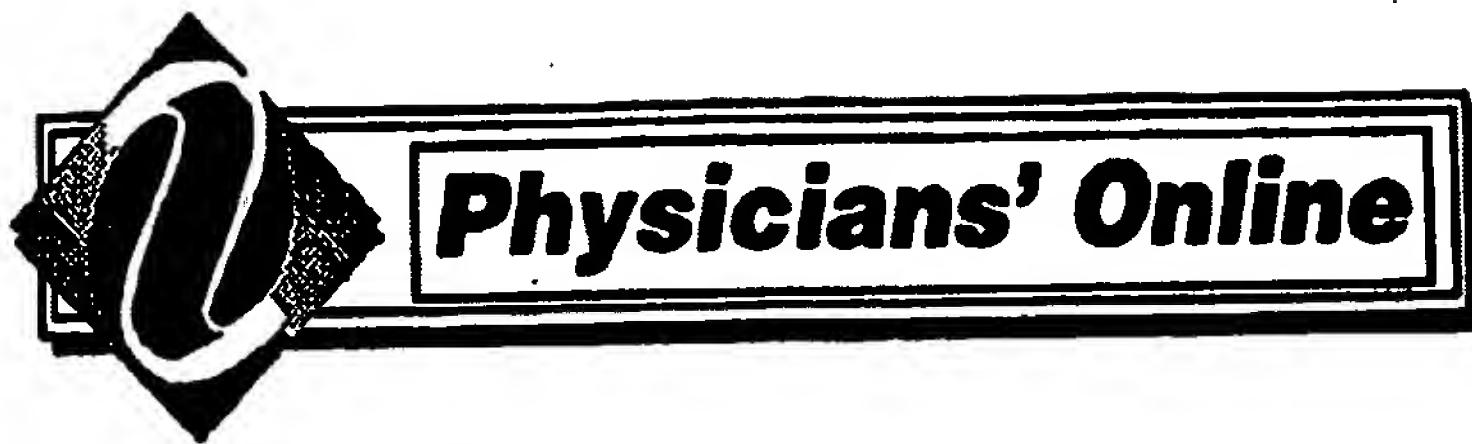
Keys to Success

- Physician Membership & Use
- Market-driven not Technology-driven
 - Systems Integrator of Existing & Leading Technology
 - "Physician-centric" Market Strategy
- Integral Industry Participation
- "First-Mover" Advantage



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12-Jan-93



A personalized online medical information & communications service dedicated to empowering physicians with the tools essential to advance the quality and control the cost of health care through informed decision-making.

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Areas for Potential Collaboration

MEDCO:

"Smart Electronic Prescription Pads"

- Online Prescription Fulfillment
- Online Prescription Claims Processing
- Pharmacists' Online

Online Cost-Containment Programs

- Online Formularies
 - NATIONAL FORMULARY STANDARD
 - Formulary Management Programs
- Online "Prudent Prescriber" Programs
 - Personal Prescribing Profiles
 - Comparison with National Standards

MMG:

Physician Targeting

- "Smart" Ads / Ad Wizard
 - Prescriber Data Linkages
 - Context-Sensitive (Static / Dynamic)
- E-mail
- Single-Sponsor Services
- Special Programming

Proprietary Prescriber-level Data

- Psychometric
 - Interactive/Survey
 - Online Behavior Surveillance
- Ad Interactions
- Database Interactions
- Concept Indexing

- Prescription Data

Detailing Support

- Rx Sampling Fulfillment
- Pharm Reps' Online
- Company Forums

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